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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,823	10/03/2003	Thomas D. Gens	00-164.1	1131

7590 11/18/2004

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EXAMINER

OMGBA, ESSAMA

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/678,823

**Applicant(s)**GENS, THOMAS D. **Examiner**

Essama Omgba

**Art Unit**

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/3/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 4, line 8, "pistons" should read --piston--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Woolcott (US Patent 3,459,253).

With regards to claim 12, Woolcott discloses a method of casting pistons comprising positioning a central bore core 5 in a mold (col. 2, lines 66-68), positioning a ring shaped core 1 in the mold to encircle the central bore core (col. 2, lines 58-63 and fig.1), pouring metal around the ring shaped core and the central bore core to produce a casting and removing the ring shaped core from the casting (col. 2, lines 68-72).

Applicant should note that the preamble has not been given any patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process

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steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

For claims 13-15, see column 2, lines 62-66 and figure 1.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolcott.

With regards to claim 12, Woolcott discloses a method of casting pistons comprising positioning a central bore core 5 in a mold (col. 2, lines 66-68), positioning a ring shaped core 1 in the mold to encircle the central bore core (col. 2, lines 58-63 and fig.1), pouring metal around the ring shaped core and the central bore core to produce a casting and removing the ring shaped core from the casting (col. 2, lines 68-72).

Although Woolcott's method is directed to casting pistons, however it would have been obvious to one of ordinary skill in the art at the time the invention was made that Woolcott's method could be used to cast axial pump barrels.

For claims 13-15, see column 2, lines 62-66 and figure 1.

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For claim 16, Applicant should note that although Woolcott uses a ring shaped core that is removed by dissolution, it would have been obvious to one of ordinary skill in the art at the time the invention was made that using a ring shaped core that is removed by breaking the ring core into small pieces is an obvious matter of design choice wherein no stated problem is solved or unexpected results obtained in using a dissoluble ring shaped core versus one that is removed by being broken in small pieces.

6. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolcott in view of Chacin U. et al. (US Patent 5,131,466).

With regards to claims 17 and 18, Woolcott discloses a method for making an axial piston pump barrel as shown above except for machining a plurality of parallelly oriented openings in the casting and attaching a plurality of check valves to the casting. However Chacin U. et al. teaches will parallelly oriented openings and check valves 18 attached to the barrel, see column 1, lines 15-19, column 2, lines 41-45, column 3, lines 41-47 and figure 2. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have machined a plurality of parallelly oriented openings in the casting of Woolcott and had attached check valves to the casting, in light of the teachings of Chacin U. et al., in order to in order to allow for the flow of fluid in the barrel.

For claims 19 and 20, see column 2, lines 45-47 of Chacin U. et al. Applicant should note that it within the general knowledge of one of ordinary skill in the art to provide appropriate valve seats for the check valves.


**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (703) 305-2915. The examiner can normally be reached on M-F (10-7:30) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Essama Omgba  
Primary Examiner  
Art Unit 3726